

REMARKS

Claims 1-20 are pending in the application. Applicant notes with appreciation the Examiner's withdrawal of the art rejections over Blake et al. in view of Copeland, Canguilhem, Hamill and Turnbull. The Examiner has requested further information under 37 C.F.R. § 1.105. Fully responsive information is set forth below. Claims 1-20 stand rejected under the enablement requirement of 35 U.S.C. § 112, First Paragraph; claims 1-20 stand rejected under 35 U.S.C. § 101. These rejections are respectfully traversed for the reasons set forth below.

Response to Requirement for Information

The Examiner has requested information as to when Exhibit B to Applicant's prior Response to Requirement for Information was published for purposes of determining whether it can be applied as prior art under 35 U.S.C. § 102(a). To the best of Applicant's knowledge, Exhibit B was never published and was never a "printed publication" under 35 U.S.C. § 102(a).

The Examiner has further requested information as to whether Clement Bowman "was the sole inventor of the product discussed in Exhibit B or whether this product was created by Mr. Bowman in collaboration with KPMG as described in Exhibit B." Applicant confirms that Clement Bowman is the sole inventor of the invention defined by each claim in the present application. As to whether Mr. Bowman was "the sole inventor of the product discussed in Exhibit B," Applicant notes that inventorship can only be determined with respect to inventions as claimed in a patent application; thus, Applicant cannot make a determination as to inventorship of the product described in Exhibit B. What Applicant can do, however, is state that to the best of his knowledge no other

person, including any person associated with KPMG, was an inventor or co-inventor of any invention defined by any claim of the present application.

Claims 1-20 Meet the Enablement Requirement of § 112

The Examiner asserts that claims 1-20 do not meet the enablement requirement of 35 U.S.C. § 112, First Paragraph. Specifically, the Examiner points to three limitations in claim 1 that she believes are not enabled. Applicant respectfully disagrees, and traverses for the reasons set forth below.

The provisions of 35 U.S.C. § 112, First Paragraph, require that the specification of a patent application contain a written description of the invention which enables a person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention. However, the specification need not teach, and may assume, that which is common and well known to persons skilled in the relevant art. Mowry v. Whitney, 81 U.S. (14 Wall.) 620, 623 (1871). “[S]kill in the art can be relied upon to supplement that which is disclosed as well as to interpret what is written.” Rengo Co. Ltd. v. Molins Mach. Co., Inc., 657 F.2d 535, 549 (C.A.N.J. 1981) (citing In Re Bode, 550 F.2d 256 (C.C.P.A. 1977)).

With respect to the claim limitation “establishing a first independent variable and a second independent variable...”, Applicant respectfully asserts that the meaning of the term “independent variable” and how to “establish variables” are well understood by those skilled in the art. Indeed, the term “independent variable” is even defined in Webster’s Ninth New Collegiate Dictionary, 1990 Merriam Webster Inc. That term is defined therein as “a mathematical variable whose value is specified first and determines

the value of one or more other values in an expression or function < in $Z=X^2 + 3XY+Y^2$, X and Y are independent variables>”.

Nonetheless, in view of the assertion in the office action that “the Applicant does not provide any steps of how a user is to ‘establish variables’ or determine whether two variables are independent,” Applicant directs the Examiner’s attention to the following disclosure in the specification of the present application. At page 6, line 18, through page 7, line 15, the specification teaches how to select independent variables, and gives examples of same. Figures 1a, 1b, 1c, 1d, 4a, 4b, 5, 6, 8, 10, 11 and 12 include examples of independent variables. See also the discussion of each of those drawings throughout the specification. As will be understood from the above-recited disclosure, and particularly from the disclosure at page 7, lines 14-15, the step of establishing first and second independent variables is the selection of at least two independent variables. It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation “establishing a first independent variable and a second independent variable....” Applicant further incorporates into this Reply the arguments presented by Applicant at pages 13-14 of the Response filed November 5, 2004, which were sufficient to overcome this same § 112 rejection three years ago.

With respect to the claim limitation “establishing a series of performance criteria statements...”, the Examiner’s attention is directed to the following disclosure in the specification of the present application. Page 7, line 10, to page 10, line 5, teaches how to establish performance criteria statements, and discloses examples of same. FIG. 2 provides examples of twenty (20) different performance criteria statements. That is

clearly a series. Furthermore, it will be clear from page 7, lines 10-14, and from the face of claim 1 as-filed, that these are statements probative of the value of the first and second variables chosen. With respect to the Examiner's statement that Applicant does not provide steps as to how to perform the step of establishing performance criteria statements, it is respectfully asserted that a person skilled in the art would certainly understand how to establish the same in view of (a) Applicant's twenty (20) examples in FIG. 2, (b) the disclosure at page 7, line 10, to page 10, line 5 of the specification, and (c) the limitation requiring that they are statements "probative of the value of the first and second variables chosen." It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation "establishing a series of performance criteria statements...." Applicant further incorporates into this Reply the arguments presented by Applicant at pages 14-15 of the Response filed November 5, 2004, which were sufficient to overcome this same § 112 rejection three years ago.

With respect to the claim limitation "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest," the Examiner's attention is directed to the following disclosure in the specification of the present application. FIG. 3; page 3, lines 12-13; page 5, line 7; page 5, lines 18-19; FIG. 6; page 10, line 7, to page 11, line 12; page 13, line 18, to page 15, line 10; FIG. 9; and page 16, line 11, to page 17, line 6. Applicant notes particularly the performance criteria scoring form of FIG. 3, the description at page 13, line 18, to page 15, line 10, regarding computerized scoring processes, the spreadsheet of FIG. 9 illustrating the results of a

computer calculation of scores, and the description of that computer calculation at page 16, line 11, to page 17, line 6. These portions of Applicant's disclosure clearly teach a person skilled in the art how to score each of a series of performance criteria statements to produce a plurality of scores their applicability to a specific intangible asset of interest.

It is respectfully asserted in view of all of the above that the specification meets the enablement requirement of 35 U.S.C. § 112 with respect to the claim limitation "scoring each of said performance criteria statements to produce a plurality of scores which reflect the applicability of said performance criteria statements to said specific intangible asset of interest."

Claims 1-20 Meet the Statutory Subject Matter Requirement of § 101

The Examiner asserts that claims 1-20 do not meet the statutory subject matter requirement of 35 U.S.C. § 101. In particular, the Examiner asserts that the invention does not meet Section 101 because it does not produce a concrete and tangible result. The rejection is respectfully traversed for the reasons set forth below.

Section 101 states that whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor. The Federal Circuit has ruled that a process is patentable under Section 101 if it produces a 'useful, concrete, and tangible result'. State Street Bank & Trust Co. v. Signature Financial Group, Inc. 149 F. 3d 1368, 1373-74, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998).

Claim 1 clearly recites a process that produces a concrete and tangible result. The concrete and tangible result is set forth in the penultimate steps of the claimed process, which are reproduced below for reference:

using a printer to transform physical media into a chart by physically plotting on said media a first axis relating to said first variable and a second axis relating to said second variable;

using said printer to physically plot a point on said chart, said point being located at coordinates corresponding to said first and second total scores, respectively....

In transforming physical media into a chart by physically plotting first and second axes on the media, and then physically plotting a point on the chart at coordinates corresponding to total scores generated in previous steps of the process, the claimed process unquestionably produces a concrete and tangible result, and meets the requirements of Section 101.

The Examiner cites In Re Swartz for the proposition that where an asserted result produced by the claimed invention is “irreproducible” the claim should be rejected under Section 101. The invention in In Re Swartz related to cold fusion. The PTO provided substantial evidence that those skilled in the art would "reasonably doubt" the asserted utility and operability of cold fusion. The Examiner found that the inventor had not submitted evidence of operability that would be sufficient to overcome reasonable doubt.

The Federal Circuit found that the *utility* requirement of Section 101 mandates that the invention be operable to achieve useful results, and that the claimed invention did not meet that *utility* requirement because it was *inoperative*.¹ In particular, the claimed invention could not reproducibly generate cold fusion, and therefore did not meet the utility requirement of Section 101. See In Re Swartz, 232 F. 3d 862, 864, 56 USPQ2d 1703, 1704 (Fed. Cir. 200).

The presently claimed invention, on the other hand, is clearly reproducible, and clearly operative under Section 101. The present invention is not cold fusion, and there is no question that it works. The claimed invention will always result in physical media with two axes physically plotted thereon, and a point physically plotted at coordinates corresponding to total scores generated in previous steps of the process. While the appearance of the resulting physical media may differ depending upon the particular scores generated in accordance with previous steps in the process, the claimed process reproducibly results in physical media with two axes physically plotted thereon, and a point physically plotted at coordinates corresponding to such scores. Thus, the claimed process is clearly not “irreproducible” under In Re Swartz.

The present inventor, Clement W. Bowman, has invented a new and useful process, which produces a concrete and tangible result, and under 35 U.S.C. § 101 Mr. Bowman is entitled to obtain a patent therefor.

¹ Contrary to the Examiner’s assertion, In Re Swartz does not stand for the proposition that the same result must occur every time the claimed method is practiced.

CONCLUSION

Having fully complied with the Requirement for Information, it is submitted that claims 1-20 are in condition for allowance and Notice to that effect is respectfully solicited. In the event that the Examiner is of the opinion that a brief telephone or personal interview will facilitate allowance of one or more of the above claims, he is courteously requested to contact applicant's undersigned representative.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "Richard E. Kurtz, II", written in a cursive style.

Richard E. Kurtz, II (Reg. No. 33,936)
Attorney for Applicants

GREENBERG TRAURIG
1750 Tysons Boulevard, 12th Floor
McLean, VA 22102
(703) 749-1330
E-mail: kurtzr@gtlaw.com

Filed: February 16, 2007